

## **REMARKS**

This is intended as a full and complete response to the Final Office Action dated May 5, 2010, having a shortened statutory period for response set to expire on August 5, 2010. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-18, 20-22, and 24-30 are pending in the application. Claims 1-18, 20-22 and 24-30 remain pending following entry of this response. Claims 1, 7, 17 and 26 have been amended. Applicants submit that the amendments do not introduce new matter.

Further, Applicants are not conceding in this application that those amended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the claimed subject matter. Applicants respectfully reserve the right to pursue these (pre-amended claims) and other claims in one or more continuations and/or divisional patent applications.

### Statement of Substance of Interview

On June 29, 2010, a telephonic interview was held between Gero G. McClellan, attorney of record, Casey S. Parks (attorney), and the Examiner. The parties discussed the cited references including *McClung*. Claim 1 was discussed. The parties also discussed proposed amendments to claim 1. The proposed amendments are reflected in this response.

During the interview, Applicants argued that *McClung* fails to teach or suggest all the elements of claim 1. No agreement could be reached at the time of the interview regarding *McClung*, but the Examiner agreed that the proposed amendments discussed would overcome the section 101 rejection.

### Claim Objections

The amendment filed 8/3/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. Specifically, the Examiner states that “[i]n claim 7, a limitation is added that an explanation for crediting is provided *to the customer*.” (Emphasis in Original). Accordingly, Applicants have amended claim 7 to read, in part, “providing an explanation for crediting the credit card account of the customer.” Claims 17 and 26 have been similarly amended. As such, Applicants respectfully request the objection be withdrawn.

### Claim Rejections - 35 U.S.C. § 101

The Examiner rejects claims 1-12 under 35 U.S.C. 101, arguing the claimed invention is directed to non-statutory subject matter. Claim 1 has been amended to incorporate proposed amendments discussed during the telephonic interview, which the Examiner agreed would overcome the current 35 U.S.C. 101 rejection. Specifically, amended claim 1 recites specific hardware (computer processor) particularly configured to determine whether an item is purchased using a store credit card account for the store from which the item is purchased. As such, Applicants respectfully submit that amended claims 1-12 are directed towards statutory subject matter and request the rejection be withdrawn.

### Claim Rejections - 35 U.S.C. § 103

The Examiner rejects claims 1-11, 13-18, 20-22 and 23-28 under 35 U.S.C. 103(a), arguing the claims are unpatentable over *McClung* (U.S. Pub No. 2004/0143502, hereinafter “*McClung*”).

The Examiner rejects claims 11, 12, 29 and 30 under 35 U.S.C. 103(a), arguing the claims are unpatentable over *McClung* in view of *Walker et al.*, (U.S. Pub No. 2001/0042785, hereinafter “*Walker*”).

The Examiner takes the position that, regarding claims 1-7, 11, 13-18, 22 and 24-26, the Examiner argues that:

*McClung* teaches a host computer system as tracking a transaction by the item and purchase price, receiving and storing price matching data

including an item match price, comparing the purchase price to a comparison price (item match price) periodically (over different time periods), and administering a credit for the price differential to the customer if the comparison price is lower than the purchase price (Paragraph 0007). The system would inherently have to obtain an account number (customer identification number) in order to credit the customer's account. *McClung* also teaches the credit card account as being an account with the vendor (Paragraph 0008, Sentence 3 and Paragraph 0131, Sentence 1). A step of determining whether a user is using a vendor credit card (and therefore, signed up through a vendor) is inherent when a purchase takes place via credit card (regular Visa versus a store card, and vice versa). *McClung*, however, does not specify what action takes place should a user not have an account with the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up.

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2141. Establishing a *prima facie* case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

Respectfully, Applicants submit that the Examiner has not properly characterized the teachings of the references and/or the claims at issue. Accordingly, a *prima facie* case of obviousness has not been established.

Applicants respectfully submit that *McClung* does not teach or suggest all the claim limitations. For example, *McClung* does not teach or suggest determining whether the item is purchased using a store credit card account for the store from which

the item is purchased. The Examiner argues that “[a] step of determining whether a user is using a vendor credit card (and therefore, signed up through a vendor) is inherent when a purchase takes place via credit card (regular Visa versus a store card, and vice versa).” Respectfully, the Examiner misconstrues the limitations of the current claim 1. Applicants respectfully submit that a payment acceptance system such as that disclosed in the *McClung* reference may receive information as to the method of payment for a purchase transaction, but may not necessarily “determine” whether a specific “item” was purchased with a using a store credit card account. For example, suppose that a consumer purchased multiple items in one transaction but provides partial payment in cash and partial payment via credit card. The system would recognize that the transaction as a whole has been completely paid for, but would not distinguish as to which items in the transaction were paid for by cash and which items were paid for by credit card. In other words, the type of payment is only linked to the transaction as a whole and not to the individual items purchased. Therefore, a system such as that taught in *McClung* would not necessarily include information as to whether an item is purchased using a store credit card account. Therefore, the inherency relied upon by the Examiner is flawed.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

As another example, *McClung* does not teach or suggest that different actions are performed based upon the determination of whether the item is purchased using a store credit card account for the store from which the item is purchased. As recited in the claims, price guarantee credits are given only for items purchased using a store credit card account, whereas, for items not purchased using a store credit card account, a notification is given to the customer about the potential credits obtainable if the store credit card had been used. In other words, the claims recite performing different actions

based on whether a store credit card account is used to purchase the item. *McClung* teaches no such distinction.

As yet another example, *McClung* does not teach or suggest notifying the customer of potential credits obtainable if the store credit card had been used, if the item is not purchased using the store credit card account. The Examiner argues that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up.” Applicants respectfully submit that the Examiner has mischaracterized the teachings of the cited reference and has applied improper hindsight in stating that such feature would have been obvious. *McClung* does not teach or suggest any different treatment between customers who used store credit cards to make a purchase and those who did not, since *McClung* discloses providing price guarantees to customers without distinguishing treatments between customers who have store credit cards and those who do not. Therefore, there is no teaching or suggestion by *McClung* for notifying customers of the potential credits.

The other pending independent claims are rejected pursuant to the same rationale as was claim 1 and, accordingly, are believed to be allowable for the same reasons given above. Since Applicants believe that the independent claims are allowable, the dependents are therefore also believed to be allowable.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 698-4286, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Gero G. MCCLELLAN, Reg. #44227/

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